Remarks

Claims 1-79 were pending. Claims 6, 28-29, 34-58, 67-71, and 76-79 were cancelled without prejudice to prosecution in another application, and no new claims are added. Therefore, claims 1-5, 7-27, 30-33, 59-66, and 72-75 are now pending.

Amendments

Claim 1 was amended to include the language of original claim 6.

Claim 7 was amended to change the dependency to claim 1, due to the cancellation of claim 6.

Claims 16 and 61 were amended to remove unnecessary punctuation in "SEQ. ID. NO." and to remove the Markush language.

Claim 17 was amended to depend from claim 1.

Claim 25 was amended to depend from claim 7.

Claim 26 was amended to depend from claim 12.

Claim 27 was amended to depend from claim 18.

Claim 30 was amended to depend from claim 5.

Claim 32 was amended to correct the antecedent basis.

Claim 33 was amended to depend from claim 25, and to correct the antecedent basis.

Restriction Requirement

Although Applicants disagree that a lack of unity has been demonstrated, the claims have been substantially revised to simplify the issues and better illustrate that these claims involve a common inventive step that establishes unity of invention. Reconsideration of the restriction requirement is requested in view of these amendments.

The pending claims of the present application were restricted into eight groups. The Restriction Requirement concluded that the present invention does not correspond to a technical feature that makes a contribution over the prior art in view of PCT publication WO 94/07474. Applicants disagree, and request reconsideration.

Claim 1 has been amended to clarify that is it directed to a method of inducing apoptosis by both inducing differentiation and inhibiting a cell fate determining function of a Notch protein in a target cell. The WO 94/07474 publication does not disclose or suggest the claimed method of *both* inducing differentiation of the cell *and* inhibiting a cell fate determining function of a Notch protein in the cell.

Because, the claims of the present application make an inventive step over the prior art of WO 94/07474, a sufficient *prima facie* case has not been made to support the present restriction requirement, and Applicants request that it be withdrawn. In addition, Applicants note that during the international proceeding of the present application, unity of invention was found. Although the U.S. Patent and Trademark Office is not bound by the PCT finding of unity, this is evidence that the claims have been considered by others to define an inventive step that distinguishes the prior art.

Furthermore, it is not possible to restrict the generic claims in the manner requested in the restriction requirement (e.g. Groups I and II) because the generic claims do not recite antibodies or oligonucleotides, but are instead generic to inducing apoptosis by inducing differentiation and inhibiting a cell fate determining function of a Notch protein in a target cell. The use of Notch antibodies or antisense molecules are only some specific examples of particular embodiments. Therefore, Groups I and II should be examined in the same application. Group I (directed to methods of inducing apoptosis by administering an antibody that antagonizes Notch protein function) and Group II (directed to methods of inducing apoptosis by administering an oligonucleotide that antagonizes Notch protein expression) are inherently interconnected. The generic independent claim does not make the distinction as to which agent is used to antagonize Notch function, and the claims must be examined as theyare written. Therefore, the invention of Group I is not independent or distinct from the invention of Group II.

In order to perform a thorough search of the prior art relevant to the broadest claim as written, claim 1, which is directed to methods of inducing apoptosis by inhibiting a cell fate determining function of a Notch protein, the prior art relevant to the claims of both Group I and Group II will have to be searched. This is because claim 1 contains no limitation on the agent used to inhibit Notch protein function. Hence, an examination of claim 1 will inherently find references directed to all of Groups I and II. Therefore, there is no additional burden on the Examiner to search the claims of Groups I and II. In the absence of any burden on the U.S. Patent and Trademark Office, Groups I and II should be examined in the same application.

In addition, the composition claims (claims 59-66) should also be examined in the same application as Groups I and II under the unity of invention standard. The composition claims are generally directed to a composition that includes both a differentiation inducing agent and a molecule that specifically interferes with Notch expression or a cell fate determining function ofNotch protein, in antineoplastic amounts. Because claims 59-6, in addition to Groups I and II, involve the sameinventive

step over the prior art of WO 94/07474, there is unity of invention and Applicants request that these claims be examined in the same application.

If the Examiner has any questions regarding the present response, she is invited to telephone the undersigned.

Respectfully submitted,

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